

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

1. Rejection of Claims 1-27, 30-32, 34-37 and 41-43 under 35 U.S.C. § 102(e).

Claims 1-27, 30-32, 34-37 and 41-43 were rejected under 35 U.S.C. § 102(e) as being anticipated by Tree (U.S. Pat. App. Publ. 2002/0145943).

(a) Claim 1. Claim 1 is an independent claim within the application drawn to a data marker integrated device communication system.

In support of the rejection it is asserted that Tree teaches every aspect of Claim 1. This assertion is made by indicating paragraph numbers within the Tree references alongside of each element Claim 1. The rejection does not state specifics about these paragraphs which are directed against the claim aspects, wherein Applicant is required to try and assess what in these paragraphs relates to the claim element against which it was asserted.

However, it is clear that the rejection of Claim 1 suffers from shortcomings, as not all aspects of the claim are being considered with regard to the Tree reference, while other aspects of the claim are misconstrued in relation to the Tree reference.

One significant shortcoming is that nothing from the Tree reference is put forth toward anticipating the fourth element of Claim 1, which recites: "*said second device configured for establishing a separate second wireless connection*". There is no teaching in Tree which asserts the use of the second device configured for a first and a separate second wireless connectivity.

This is not surprising as the Tree reference provides no relevant teachings toward the objects of Applicant's invention. The object of the Tree reference, as reflected in the Abstract, Summary on paragraphs [0007]-[0008], and throughout the description in Tree is that of "*an electronic data marking device integrated into a standard wristwatch and is configured to perform the functions of an e-marker device.*"

Furthermore, it is clear from the descriptions within the Tree reference that the data marker device is conventionally configured, wherein one relies on a user terminal (PC) in a conventional manner to download information from the watch to a PC, which can then log into the server to which the data is communicated. The type of connection between the wristwatch and user terminal is then in paragraph [0022] of Tree, which may be *"a micro-jack, an infra-red (IR) port, a Bluetooth transfer protocol enabled port, or any other types of available terminals which is compatible with the respective terminal at the gateway device for data communications."* Yet, these teachings are only directed to the communication between the wristwatch data marking device and the user terminal. Tree does not teach the use of a network device (second device) which is separate from the user terminal, and does not even discuss the use of a user terminal containing separate first and second wireless connections.

One can readily recognize that the functionality of user terminal 105 described in the instant application is not the same as that of network device 102. Discussion on page 10 of the instant application makes this clear, such as lines 15-17 on page 10: *"and further, frequent transmission of marked data is possible without the need to use a gateway terminal (for example, user terminal 105) for transmitting marked data."* As a side note, it will be recognized that amended Claim 6 further describes the relationship for wirelessly transmitting marked data to the second device as being contemporaneous (i.e., "at or near the same time" as it is often known by common use definition), which even further distinguishes the application with regard to the second device (network device).

The fifth element of Claim 1 describes the relationship between the network device (second device) and a server as *"a server configured to connect over said second wireless connection to said second device for data communication through said second device with said first device"*. However, in support of the rejection the above network device (element 102 in FIG. 1 of instant application) is equated to the relationship to a user terminal (element 105 in FIG. 1 of instant application), although

these do not comport with one another as discussed above. In addition, in the last element of Claim 1, the operation of a user terminal is recited, this operation being separate from that of the second device, which is referred to in the specification as a network device.

Support for an anticipation rejection requires that every claim element must be taught or inherent in a single prior art reference, Manual of Patent Examining Procedure (MPEP) §706.02a. Based on the above discussion it is clear that Claim 1 is thus not anticipated by the relied-upon reference.

Applicant respectfully asserts that Claim 1 is novel over the Tree reference, and the Applicant respectfully requests that the rejection of Claim 1 and the claims that depend therefrom be withdrawn.

(b) Claim 20. Claim 20 is an independent claim in the application drawn to a method.

In support of the rejection the same paragraphs are asserted from the Tree reference.

However, the rejection lacks support as the elements recited in Claim 20 are not met by that which is taught in the Tree reference.

In particular paragraph [0038] of Tree is used in support of "*establishing a second wireless connection from said second device to a server*". Yet, the paragraph relied-upon does not discuss establishing a second wireless connection, and only refers to connection of the PC gateway to the wristwatch data marking device. In addition, the problem mentioned in regard to Claim 1 still exists where the second device is being considered as the user terminal.

Support is thus lacking for the anticipation rejection, as not every claim element is taught or inherent in a single prior art reference.

Applicant respectfully asserts that Claim 20 is novel over the Tree reference, and the Applicant respectfully requests that the rejection of Claim 20 and the claims that depend therefrom be withdrawn.

(c) Claim 31. Claim 31 is an independent claim in the application drawn to a method.

In support of the rejection aspects and paragraphs from the Tree reference are asserted.

However, as with Claims 1 and 20 the rejection lacks support as the elements recited in Claim 31 are not met by that which is taught in the Tree reference.

In particular paragraphs [0022], [0025], [0031] and [0038] of Tree are used in support of “*said second device comprising a mobile device configured for establishing a Bluetooth protocol connection and a separate second communication connection having a longer range than said Bluetooth protocol connection*”.

Again, the rejection does not state specifics from these which are directed against the claim aspects, wherein Applicant is required to determine what the Examiner may be alluding to. Paragraph [0022] discusses the types of ports that can be utilized on “*watch body 101*” in connecting to the user terminal. Paragraph [0025] describes marking of music clips on the marking device and the display of indications of how many e-marks are stored. Paragraph [0031] describes connecting the personal computer user terminal to the internet, as well as utilizing a Bluetooth protocol in connecting the data marking wristwatch to the user terminal.

Nowhere, however, in these referenced paragraphs do we find support for establishing a second separate wireless connection. In addition, the problem mentioned in regard to Claim 1 still exists where the second device is being considered as the user terminal.

Furthermore, in order to provide a breadth of independent claim coverage, the material of amended Claim 6 was incorporated into Claim 31, and describes communicating through the first wireless connection to the second device as being “*contemporaneous with storing of said data mark*”. It will be appreciated that this further differentiates from Tree, which provides no discussion of wirelessly communicating the data marks through a second wireless communication device to a server in response to

entry of those marks into the data marking device.

Support is thus lacking for the anticipation rejection, as not every claim element is taught or inherent in a single prior art reference.

Applicant respectfully asserts that Claim 31 is novel over the Tree reference, and the Applicant respectfully requests that the rejection of Claim 31 and the claims that depend therefrom be withdrawn.

(d) Claim 42. Claim 42 is an independent claim in the application drawn to a data marker integrated device communication system.

In support of the rejection paragraph numbers referring to portions of the Tree reference are given without explanatory aid.

However, as with Claims 1, 20, and 31, the rejection lacks support because the elements recited in Claim 42 are not met by that which is taught by Tree.

In particular paragraphs [0024], [0031] and [0038] of Tree are used in support of *"means for establishing a second wireless connection from said second device to a server"*.

Paragraph [0024], however, discusses the user making a connection *"to the user's e-marker account at the e-marker web site, upon verification of the user's identity corresponding to the e-marker account that the user is attempting to access."* However, Applicant finds nothing in this paragraph discussing *establishing a second wireless connection*. The remaining paragraphs listed also do not support this aspect of the invention as discussed for preceding claims.

Toward supporting *"wherein said first wireless connection is a local, short range, wireless protocol that differs from said second wireless connection"*, the rejection notes paragraphs [0022], [0025], [0031] and [0038], which have been previously discussed and lack any teaching whatsoever of the use of a first and second wireless connection. Other aspects of the claim describe the two separate wireless connections and are not supported by the teachings of Tree.

In addition, the problem mentioned in regard to Claim 1 still exists where the second device is equated to the user terminal, which is separately recited in this claim for *"establishing an internet connection between said server and a user terminal"*.

As brought out with regard to the other claims, support is lacking for the anticipation rejection, as not every claim element is taught or inherent in a single prior art reference.

Applicant respectfully asserts that Claim 42 is novel over the Tree reference, and the Applicant respectfully requests that the rejection of Claim 42 and the claims that depend therefrom be withdrawn.

(e) Claim 43. Claim 43 is an independent claim in the application drawn to a data marker integrated device communication system.

In support of the rejection are found the paragraphs from Tree which are discussed many of the claims discussed above.

However, as with Claims 1, 20, 31 and 42 the rejection lacks support as the elements recited in Claim 43 are not met by that which is taught by Tree.

In particular support is lacking for *"means for transmitting said received data mark through a second wireless connection, which is separate from said first wireless connection, to a server"*, while other portions of the support do not properly represent all aspects of the claim. It will be noted that said second wireless device is performing a function different than the user terminal which is described as, *"accessing information corresponding to said marked data on said server"*.

Consequently, it is seen as with the previously discussed independent claims that support is lacking for an anticipation rejection, as not every claim element is taught or inherent in a single prior art reference.

Applicant respectfully asserts that Claim 43 is novel over the Tree reference, and the Applicant respectfully requests that the rejection of Claim 43 and the claims that depend therefrom be withdrawn.

(f) Claims 2-19, 21-27, 30, 32, 34-37, and 41. This group of claims depends from independent claims whose novelty has been discussed, and should be considered *a fortiori* allowable in view of those claims.

2. Rejection of Claims 1-27, 30-32, 34-37 and 41-43.

The above group of claims was rejected on the basis of non-statutory obviousness-type double patenting as being unpatentable over Claims 1-18 of U.S. Patent No. 7,127,454 and Claims 1-26 of U.S. Patent No. 7,107,234.

Although Applicant does not agree that these claims are not patentably distinct, Applicant will consider filing a properly-worded terminal disclaimer when the double patenting rejections are the sole remaining impediment to patentability.

3. Rejection of Claims 1-27, 30-32, 34-37 and 41-43.

The above group of claims were rejected on the basis of non-statutory obviousness-type double patenting as being unpatentable over Claims 1-12 of U.S. Patent No. 7,190,971, Claims 1-17 of U.S. Patent No. 7,062,528, and Claims 1-61 of U.S. Patent No. 6,578,047.

Although Applicant does not agree that these claims are not patentably distinct, Applicant will consider filing a properly-worded terminal disclaimer when the double patenting rejections are the sole remaining impediment to patentability.

4. Amendment of Claims 6, 8 and 31.

Claim 6 and 31. Amended Claims 6 and 31 recite an implementation of the invention with greater particularity, while further distinguishing over the cited references.

Dependent Claim 6 has been amended to recite the aspect of
"contemporaneously transmitting the marked data wireless to said second device in response to inputting or storing said data marks on said data marker integrated device".

Independent Claim 31 has been similarly amended *"contemporaneous with*

storing of said data mark", in describing transmitting of stored data mark. Applicant finds nothing of this nature taught positively recited in the Tree reference.

Support for this aspect of the invention is found in the instant application on page 9, lines 6-15.

Claim 8. Dependent Claim 8 has been amended to recite an implementation of the invention with greater particularity, while further distinguishing over the cited references.

Dependent Claim 8 has been amended to recite the aspect of "*encrypting and decrypting data communication on said second wireless connection*".

Support for this aspect is found in the specification, including page 8, lines 2-8.

5. Amendments Made Without Prejudice or Estoppel.

Notwithstanding the amendments made and accompanying traversing remarks provided above, Applicant has made these amendments in order to expedite allowance of the currently pending subject matter. However, Applicant does not acquiesce in the original grounds for rejection with respect to the original form of these claims. These amendments have been made without any prejudice, waiver, or estoppel, and without forfeiture or dedication to the public, with respect to the original subject matter of the claims as originally filed or in their form immediately preceding these amendments. Applicant reserves the right to pursue the original scope of these claims in the future, such as through continuation practice, for example.

6. Conclusion.

Based on the foregoing, Applicants respectfully request that the various grounds for rejection in the Office Action be reconsidered and withdrawn with respect to the presently amended form of the claims, and that a Notice of Allowance be issued for the present application to pass to issuance.

In the event any further matters remain at issue with respect to the present

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application, Applicants respectfully request that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Date: January 4, 2008

Respectfully submitted,

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